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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/517,197	12/08/2004	Jakob P. Ley	47940	7605

1609 7590 08/31/2006

ROYLANCE, ABRAMS, BERDO & GOODMAN, L.L.P.  
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EXAMINER

KUMAR, SHAILENDRA

ART UNIT PAPER NUMBER

1621

DATE MAILED: 08/31/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/517,197	<b>Applicant(s)</b> LEY ET AL.	
	<b>Examiner</b> SHAILENDRA -. KUMAR	<b>Art Unit</b> 1621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 21 August 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-14 and 16-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 and 16-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 8/21/06 has been entered.

Claims 1-14, and 16-19 are pending in this application.

#### ***Claim Rejections - 35 USC § 103***

2. Claims 1-13 and 16-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walpole et al or Wood et al.

Walpole et al(J. Med. Chem, 1993) or Wood et al (FEBS, 1990) teach structurally similar compounds, composition and method of use as claimed herein. See for example, Walpole et al, page 2375, compound 8e and Wood et al, page 383, compound F in Table I. The difference between the reference and herein claimed compounds and composition is that in the instant claims above compounds have been proviso out.

It would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to obtain adjacent homologs, or lower or higher homologs of the reference compounds, because they are structurally so similar to those claimed herein, with the reasonable expectation of achieving a successful flavoring composition, absent evidence to the contrary. In re Hass, 141 F.2d 127, 60 USPQ 548.

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Applicants' arguments were fully considered and were not found convincing.

Applicants argue that the references do not suggest aromatic effect and especially compounds disclosed in Wood et al would be expected by one of ordinary skill in the art to have little or no capsaicin activity. Applicants have not compared their compounds with the reference compounds and appears to be mere speculative statement.

Inasmuch the compounds are structurally similar, they are supposed to be possessing similar activity, absent evidence to the contrary. In re Papesch, 315 F. 2d 381, 137 USPQ 43.

3. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over WO'258, in view of Walpole et al or Wood et al.

Instant claim is directed to a process of preparing mandelic alkylamide compounds, wherein, carboxylic acid derivative is reacted with an amine.

WO'258 is teaching a similar process of preparing structurally similar compounds as claimed herein, wherein, carboxylic acid derivative is reacted with an amine, similar to herein, see page 8, last line. The difference between the reference and herein claimed process is that the reference is using alkyl amine which is lower in alkyl chain length than claimed herein.

It would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to modify the process of WO'258, by using higher alkyl chain length amine, because the process is analogous, and additionally, Walpole et al or Wood et al are expressly teaching that structurally similar compounds having longer alkyl chain are old in the art, with the reasonable expectation of achieving structurally

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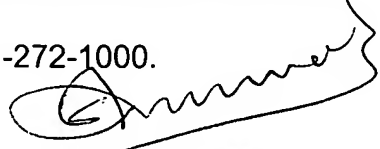
similar compounds as claimed herein, absent evidence to the contrary. In re Durden, Jr. et al., 226 USPQ 359.

Applicants' arguments that WO'258 teaches two hydroxyl as against one hydroxyl, is of little if any probative value because the the process is analogous and Walpole or Wood et al are expressly teaching one hydroxyl compounds.

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to SHAILENDRA -. KUMAR whose telephone number is (571)272-0640. The examiner can normally be reached on Mon-Thur 8:00-5:30, Alt Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman Page can be reached on (571)272-0602. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



SHAILENDRA - KUMAR  
Primary Examiner  
Art Unit 1621

S. Kumar  
8/29/06

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8/29/06